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08/464,034

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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08/464,034 06/05/95 HYATT

G 751 EXAMINER

GILBERT P. HYATT
PO BOX 81230
LAS VEGAS NV 89180

26M2/0825

SHALWALA, B 21 ART UNIT PAPER NUMBER

2616 DATE MAILED:

08/25/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

Responsive to communication(s) filed on 3/24/97

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 95-291 is/are pending in the application.

Of the above, claim(s) 98-124, 126, 128-129, 131-214, 216, 219-220, 223-224 is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 95-97, 145, 147, 130, 215, 217-218, 221-222 is/are rejected.

Claim(s) _____ is/are objected to.

Claim(s) 98-124, 126, 128-129, 131-214, 216, 219-220, 223-224 are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of Reference Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

DETAILED ACTION

1. Since this application is eligible for the transitional procedure of 37 C.F.R. § 1.129(a), and the fee set forth in 37 C.F.R. § 1.17(r) has been timely paid, the finality of the previous Office action is hereby withdrawn pursuant to 37 C.F.R. § 1.129(a). Applicant's first submission after final filed on March 25, 1997 has been entered.

Election/Restriction

2. Restriction to one of the following inventions is required under 35 U.S.C. § 121:

- I. Claims 95-97, 125, 127, 130, 215, 217-218, 221-222 are drawn to memory management and display control in an image processing system, classified in class 382, subclass 305.
- II. Claims 98-124, 126, 128-129, 131-214, 216, 219-220, and 223-291 are drawn to spatial interpolation ckt, subpixel vector change ckt, resolution reduction ckt, transform processor, weight ckt, scaling, image vector communication link, anti-aliased weight, communication link, classified in class 382, subclass 299.

3. The inventions are distinct from each from the other because of the following reasons: Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as controlling the memory and display in any type of image processing system. None of the claims of group I require any of the specifics of spatial interpolation ckt, subpixel vector change ckt, resolution reduction ckt, transform processor, weight ckt, scaling, image vector communication link, anti-aliased weight, communication link, that are specified in the claims of group II. and further, none of the claims in group I requires any type of spatial interpolation ckt, subpixel vector change ckt, resolution reduction ckt, transform processor.

weight ckt, scaling, image vector communication link, anti-aliased weight, communication link.. Therefore, the memory and display control functions of group I can be used in any image processing system. See M.P.E.P. § 806.05(d).

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. Newly submitted claims 98-124, 126, 128-129, 131-214, 216, 219-220, and 223-291 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: These claims are directed towards spatial interpolation ckt, subpixel vector change ckt, resolution reduction ckt, transform processor, weight ckt, scaling, image vector communication link, anti-aliased weight, communication link. which is not required by the originally presented claims, as pointed out more fully above.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 98-124, 126, 128-129, 131-214, 216, 219-220, and 223-291 are withdrawn from consideration as being directed to a non-elected invention. See 37 C.F.R. § 1.142(b) and M.P.E.P. § 821.03.

Response to Arguments

6. Applicant's arguments filed March 24, 1997 have been fully considered but they are not persuasive.

The applicant's remarks do not present any additional arguments regarding the merits of the claimed invention, but instead point to the earlier arguments presented with the amendment filed April 25, 1996. However, these remarks were fully addressed in the Final Office Action mailed June

27, 1996 (Paper #10; see sections 27-36). Because the applicant has not presented any new arguments or pointed out any error or deficiency in the response to the earlier arguments, the mere reiteration of these earlier arguments is not persuasive in overcoming the grounds of rejection.

Claim Rejections - 35 U.S.C. § 112

7. Claims 95-97, are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The statements of the reasons for this rejection, made in the supplemental first Office Action (Paper #5, mailed November 22, 1995; see section 3) and reiterated in the Final Office Action (Paper #10, mailed June 24, 1996; see sections 3-4), are incorporated herein, to the extent that they refer to claims 95-97.

Claim Rejections - 35 U.S.C. § 103

8. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 95-97, 125, 127, 130, 215, 217-218, 221-222 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Marsh (US 4,179,824).

Rather than repeating the extensive discussion of the applied reference, the statements advanced in the supplemental first Office Action (Paper #5, mailed November 22, 1995; see sections 6-16) as to the applicability and disclosure of Marsh are incorporated herein, as are the statements of rejection for these claims, to the extent that they refer to claims 95-97.

As to claims 125, 127, 130, 215, 218, and 221, which recites similar recitation to those of claims 95-97, discussed in the above mentioned rejection. First memory is analogous to database memory of claim 96, and second memory is analogous to image memory of claim 96, and transform processor is shown by Marsh, in section 9 of paper # 5, mailed on November 22, 1995.

As to claims 217, and 222, making product is analogous to making product of claim 94 shown by Marsh, in section 9 of paper # 5, mailed on November 22, 1995.

Double Patenting

10. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 C.F.R. § 3.73(b).

11. Claims 95-97, 125, 127, 130, 215, 217-218, and 221-222 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 8 of U.S. Patent No. 4,491,930 in view of Marsh.

Rather than repeating the extensive discussion of the reasons for rejection, the statements advanced in the supplemental first Office Action (Paper #5, mailed November 22, 1995; see sections 30-33) as to the applicability of the rejection are incorporated herein, as are the statements of rejection for these claims. And regarding claims 125, 127, 130, 215, 217-218, and 221-222, refer to the paragraph 9 above.

Provisional Double Patenting

12. Since applicant has an extremely large number of applications pending (approximately 100 applications with the same specification as this application, plus some 300 other pending applications filed at approximately the same time as this application), no provisional double patenting rejection is being made at this time with respect to these various applications. However, applicant is reminded of the requirement to maintain clear lines of distinctions between each and every application. Currently, there appear to be numerous other pending applications (including the parent application 07/289,355) that contain potentially conflicting claims. Until claims are found to be in condition for allowance, this issue will be held in abeyance. Additionally, applicant is also notified that numerous claims in this application appear to be substantial duplicates of one another. Most of the independent claims contain the same basic limitations with, at best, very minor changes in claim language. Applicant is further reminded that double patenting can be made with respect to claims within the same application, as duplicative claims are not allowed. Such rejections can, and possibly will, be made in the future if applicant continues to attempt to prosecute claims that are substantial duplicates of one another. Additionally, the addition of duplicative claims simply adds to the number of claims that applicant must pay additional fees for, as every independent claim over 3, and every total claim over 20, increases that cost of the application, as well as the eventual amount of issue fee upon allowance of the application. Further, the elimination of substantially duplicate claims simplifies the prosecution for both applicant as well as the PTO, and will help in the speedy prosecution of the application to conclusion.

Conclusion

13. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 C.F.R. § 1.129(a) and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 C.F.R. § 1.129(a). Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action

after the submission under 37 C.F.R. § 1.129(a). See M.P.E.P. § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. § 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

14. Since the fee set forth in 37 C.F.R. § 1.17(r) for a first submission subsequent to a final rejection has been previously paid, applicant, under 37 C.F.R. § 1.129(a), is entitled to have a second submission entered and considered on the merits if, prior to abandonment, the second submission and the fee set forth in 37 C.F.R. § 1.17(r) are filed prior to the filing of an appeal brief under 37 C.F.R. § 1.192. Upon the timely filing of a second submission and the appropriate fee of \$385.00 for a small entity under 37 C.F.R. § 1.17(r), the finality of the previous Office action will be withdrawn. If a notice of appeal and the appeal fee set forth in 37 C.F.R. § 1.17(e) were filed prior to or with the payment of the fee set forth in 37 C.F.R. § 1.17(r), the payment of the fee set forth in 37 C.F.R. § 1.17(r) by applicant will be construed as a request to dismiss the appeal and to continue prosecution under 37 C.F.R. § 1.129(a). In view of 35 U.S.C. § 132, no amendment considered as a result of payment of the fee set forth in 37 C.F.R. § 1.17(r) may introduce new matter into the disclosure of the application.

15. The applicant is reminded that the finality of this action ONLY applies to the action on the merits, and NOT to the restriction requirement. Any traversal of the restriction requirement that is filed separately from any other response to this action will be fully considered. However, any traversal that is included with a response to the merits of this action under 37 C.F.R. § 1.116 is not automatically entitled to consideration.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bipin Shalwala whose telephone number is (703) 305-4938.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Leo Boudreau, can be reached on (703) 305-4706. The fax phone number for this Art Unit is (703) 308-5397.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

R

J. S. C.
PATENT EXAMINER
ART UNIT 266